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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,487	11/28/2003	William Thomas Vogt	14715/031D7007	1038
47626 7590 07/13/2007 BECKMAN COULTER INC. C/O SHELDON MAK ROSE & ANDERSON 100 East Corson Street Third Floor PASADENA, CA 91103-3842			EXAMINER ADDISU, SARA	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 07/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ED

Office Action Summary	Application No.	Applicant(s)	
	10/724,487	VOGT ET AL.	
	Examiner	Art Unit	
	Sara Addisu	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/28/03, 3/22/05, 4/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Please note that the restriction set forth in the Office Action mailed 6/13/06 has been withdrawn. Currently claims 1-16 are pending in this application.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "332" has been used to designate both "flood coating" and "printing" (see page 5, lines 16 and 23).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "biohazard warning 333 and printing 335" (see page 5 lines 17 and 23) as described in the specification.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because it is in claim format and contains legal phraseology, e.g. "comprised".. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

Art Unit: 3722

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- claim 16 recited "a shipping device prepared by the method of claim 4 or 15". It is not clear to the Examiner how claim 16 further limits claims 4 and 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strong et al. (USP 5,150,971) in view Palazzolo (USP 5,918,983).

Regarding claims 1-8, 10, 15 and 16, Strong et al. teaches a sealing envelope/shipping device/sealable device having a laminate of an outer layer (310: which can be paper or cardboard), an inner polymeric, water resistant, substantially

transparent layer (330) and a metallic water resistant substantially non-light transmissive middle layer (320, e.g. aluminum foil) ('971, figures 3 & 4 and col. 4, lines 1-24). Furthermore, Strong et al. teaches the outer layer has an outer surface which can be pre-printed with information typically imprinted on mailing envelopes ('971, col. 4, lines 15-20). Regarding claims 11-14, Strong et al. discloses the claimed invention (i.e. envelop having a polymeric layer) except for having an additional polymeric layer between the outer and middle layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an another polymeric layer to further protect/seal the outer layer with the mailing information indicia from accidental leakage of the content inside the envelope, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

However, Strong et al. fails to teach a printed biohazard warning on the inner surface.

Palazzolo teaches a security envelope having the inner surface of header (30) being corona treated during manufacture and indicia (44) such as symbols, circles, and letters ("ABC") being printed on it. Palazzolo also teaches thereafter, a translucent flood coat shown as shading (46) being printed over the entire inner surface of header (30) including the indicia (44) ('983, figures 6 & 7 and col. 4, lines 54+). Furthermore, Palazzolo teaches the ink used for indicia (44) can be of a first color, such as black or dark blue, and the ink used for flood coat 46 can be of a second color, such as yellow, and the adhesive layer 36 should be tinted with a third color, such as red, to provide the tamper evident functions ('983, col. 4, lines 60+). Furthermore, regarding claims 1 and

14, Palazzolo discloses the claimed invention (printed indicia) except for the specific arrangement and/or content of indicia (i.e. the the indicia being biohazard warning) set forth in the claims 1 and 14. It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Strong et al. such that the inner surface of its inner layer has biohazard warning printed on it, as taught by Palazzolo for the purpose of having security envelopes that impede tampering ('983, col. 1, lines 4-8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SA
7/9/07

Monica S. Carter
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SUPERVISORY PATENT EXAMINER